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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/246,695	02/09/1999	MICHITO WATANABE	2091-0186P-S	6491

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

FLYNN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/246,695

Applicant(s)

WATANABE ET AL.

Examiner

Kimberly D Flynn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 11-14, 17-23, 25-27 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 11-14, 17-23, 25-27, and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This action is in response to an Amendment filed on October 9, 2003. Claims 1-4, 6-8, 11-14, 17-23, and 25-31 are presented for further consideration.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-8, 11-14, 17-23, 25-27, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (U.S. Patent No. 6,133,985) in view of Stein et al. (U.S. Patent No. 5,826,241).

In considering claims 1, 4, 6, 8, 11-12, and 20-21 Garfinkle discloses a system comprising:

image storing means for storing a plurality of image (*See, col. 6, lines 64-67*);

image selecting means for enabling a service user to select at least one of the plurality of stored images, by enabling the stored images to be view on the network (*See, col. 4, lines 7-13 and col. 7, lines 5-10*);

mail generating means for generating an electronic mail message with the selected image as an attachment to the electronic mail message, without requiring a recipient of the electronic

mail with attached image to activate an address that point the recipient to a file which stores the selected image (*col. 5, lines 25-28 and col. 7, lines 10-16*);

destination address specifying means for enabling the service user to specify a destination address of the electronic mail message (*See Fig 5C, destination address specifying means is an inherent feature of the transmittal of electronic mail*); and

mail transmitting means for transmitting the electronic mail message to the destination address specified by the destination address specifying means (*See Fig 5C*);

While Garfinkle discloses the invention substantially as claimed, Garfinkle does not expressly disclose a user address setting means for enabling the service user to set their electronic mail address thereof, wherein the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message, and wherein the address of the sender of the electronic mail message is an automatic reply address. Nonetheless, the aforementioned limitations are well-known features of e-mail program operations as disclosed by Stein.

In the same field of endeavor Stein discloses a computerized system for making payments and authenticating transactions over the Internet, which involves sending transfer-query and transfer-result messages. Stein discloses wherein when the buyer prepares a transfer-query message; the transaction-identifier is placed in the "subject" of transfer-query message and the e-mail address to which the buyer's transfer-response message should be sent (e.g. "response @card.com") is placed in the "sender's address" of the transfer-query message. Stein also discloses wherein the conventional e-mail programs have a feature that will automatically read

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the user inputted "subject" and "sender's address" of a received message and format a reply message directed to the sender's address with the same "subject" as the received message.

Accordingly, Stein discloses the claimed user address setting means that allows the user to set their electronic mail address as the address of the sender and wherein the address set by the user is designated as the automatic reply address. It would have been obvious to a person having ordinary skill in the art to modify the system taught by Garfinkle to include the user address setting means as disclosed by Stein in order to provide the user with the ability to control the return reply, and to transmit e-mail with a reply address independent of the machine being used for transmission. Therefore, the aforementioned limitation would have been an obvious modification to the system as disclosed by Garfinkle.

In considering claim 17, the claim is substantially the same as claims 1 and 5, therefore the same grounds of rejection are applicable.

In considering claims 18, Garfinkle discloses a system comprising:

displaying a plurality of selectable images to be transmitted to a recipient as an attachment to an electronic mail message, for viewing by the user on a device of the user; selecting at least one of the plurality of selectable images at the user's device; displaying the selected at least one image in a manner that distinguishes the at least one image from the rest of the selectable images (*col. 7, lines 5-10*);

reading an image file corresponding to the selected image from a memory; converting the read image file into an attachment document format for the electronic mail message (*although not specifically stated the aforementioned features are inherent features of adding attachments to e-mail*); and

transmitting the electronic mail message with attached image to the recipient (*col. 7, lines 11-16*).

While Garfinkle discloses the invention substantially as claimed, Garfinkle does not expressly disclose a user address setting means for enabling the service user to set their electronic mail address thereof, wherein the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message, and wherein the address of the sender of the electronic mail message is an automatic reply address. Nonetheless, the aforementioned limitations are well-known features of e-mail program operations as disclosed by Stein.

In the same field of endeavor Stein discloses a computerized system for making payments and authenticating transactions over the Internet, which involves sending transfer-query and transfer-result messages. Stein discloses wherein when the buyer prepares a transfer-query message; the transaction-identifier is placed in the "subject" of transfer-query message and the e-mail address to which the buyer's transfer-response message should be sent (e.g. "response @card.com") is placed in the "sender's address" of the transfer-query message. Stein also discloses wherein the conventional e-mail programs have a feature that will automatically read the user inputted "subject" and "sender's address" of a received message and format a reply message directed to the sender's address with the same "subject" as the received message.

Accordingly, Stein discloses the claimed user address setting means that allows the user to set their electronic mail address as the address of the sender and wherein the address set by the user is designated as the automatic reply address. It would have been obvious to a person having ordinary skill in the art to modify the system taught by Garfinkle to include the user address

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setting means as disclosed by Stein in order to provide the user with the ability to control the return reply, and to transmit e-mail with a reply address independent of the machine being used for transmission. Therefore, the aforementioned limitation would have been an obvious modification to the system as disclosed by Garfinkle.

In considering claims 19 and 25, displaying a plurality of selectable images to be transmitted to a recipient as an attachment to an electronic mail message, for viewing by the user on a device of the user; selecting at least one of the plurality of selectable images at the user's device (*col. 7, lines 5-10*);

displaying at the same time a comment box (*subject box*), a destination input box (*address box*), and images (*attachments*) having been selected as targets of transmission (*although not specifically stated the aforementioned features are inherent features of adding attachments to e-mail*);

reading an image file corresponding to the selected image from a memory at the server; converting the read image file into an attachment document format for the electronic mail message (*although not specifically stated the aforementioned features are inherent features of adding attachments to e-mail*); and

transmitting the electronic mail message with attached image to the recipient (*col. 7, lines 11-16*).

While Garfinkle discloses the invention substantially as claimed, Garfinkle does not expressly disclose a user address setting means for enabling the service user to set their electronic mail address thereof, wherein the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message,

and wherein the address of the sender of the electronic mail message is an automatic reply address. Nonetheless, the aforementioned limitations are well-known features of e-mail program operations as disclosed by Stein.

In the same field of endeavor Stein discloses a computerized system for making payments and authenticating transactions over the Internet, which involves sending transfer-query and transfer-result messages. Stein discloses wherein when the buyer prepares a transfer-query message; the transaction-identifier is placed in the "subject" of transfer-query message and the e-mail address to which the buyer's transfer-response message should be sent (e.g. "response@card.com") is placed in the "sender's address" of the transfer-query message. Stein also discloses wherein the conventional e-mail programs have a feature that will automatically read the user inputted "subject" and "sender's address" of a received message and format a reply message directed to the sender's address with the same "subject" as the received message.

Accordingly, Stein discloses the claimed user address setting means that allows the user to set their electronic mail address as the address of the sender and wherein the address set by the user is designated as the automatic reply address. It would have been obvious to a person having ordinary skill in the art to modify the system taught by Garfinkle to include the user address setting means as disclosed by Stein in order to provide the user with the ability to control the return reply, and to transmit e-mail with a reply address independent of the machine being used for transmission. Therefore, the aforementioned limitation would have been an obvious modification to the system as disclosed by Garfinkle.

In considering claims 26 and 27, the claim contain similar limitations as those previously rejected in claims 1, 5, and 18 therefore the same grounds of rejection are applicable.



In considering claims 28-31, the newly added claims contain similar limitations as those previously rejected in claims 1, 5, and 18 therefore the same grounds of rejection are applicable.

4. Claims 2-3, 7, 13-14, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (U.S. Patent No. 6,133,985) in view of Parulski (EPO 0860980 A2).

In considering claims 2, 7, 13, and 22 While Garfinkle discloses allowing the photographer to perform specific task using the digital images such as e-mail, and creating photographic merchandise including t-shirts, mugs, mouse pads, puzzles, ties, buttons, etc. Garfinkle does not explicitly disclose comment-inputting means for enabling the service user to input a comment on the image selected by the image selecting means as claimed. However, inputting text on digital images is well known as evidenced by Parulski.

In similar art, Parulski teaches that such descriptive text as, "Hi, I'm having a relaxing vacation, John Smith" can be added to the digital image prior to e-mailing or albing in order to provide the recipient of the emailed image with information describing the image (See. Fig. 2, which illustrates creatives such as backgrounds and text messages being added to an image and also Pg. 3, lines 25-27, which teaches that through a software application one or more creative backgrounds and text messages can be selected by the user). The means of inputting text onto the image allows to photographer to be creative with processed images. One skilled in the art would have clearly recognized that modifying the image processing and distributing system as disclosed by Garfinkle with the comment-inputting means as disclosed Parulski would have expanded the creative capabilities of the photographer thus advantageously yielding more descriptive and creative images. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by Garfinkle.

In considering claim 3, 14, and 23 although the system taught by Garfinkle discloses substantial features of the claimed invention, it fails to disclose an attachment mode selecting means for enabling the service user to select an attachment mode by presenting a plurality of attachment modes as formats for attaching the image, wherein the mail generating means attaches the image according to the attachment mode selected by the attachment mode selecting means. Nonetheless, means for enabling the service user to select an attachment mode as a format for attaching images to email is well known as evidenced by Parulski.

In similar art, Parulski discloses an image detail section that describes different file types (e.g. FlashPix, JPEG, TIFF) for attaching images (See Fig. 4, and Pg. 4, lines 56-57). Thus, given the teaching of Parulski, a person having ordinary skill in the art would have readily recognized the desirability and advantages of including the attachment mode selecting means taught by Parulski in the digital image processing system taught by Garfinkle so that the user could choose the appropriate format to send the image in order to accommodate the recipients system capabilities. Therefore, the claimed limitation would have been an obvious modification to the system taught by Garfinkle.

#### ***Response to Arguments***

5. Applicant's arguments filed October 9, 2003 have been fully considered but they are not persuasive. Applicant contends that Stein does not teach or suggest enabling the service user to set the address of the sender of the mail message, and that Stein does not cure the deficiencies of Garfinkle. Examiner disagrees. Stein whose invention is a computerized system for making payments and authenticating transactions over the Internet discloses an e-mail program different

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from the conventional e-mail systems, which will automatically read the "subject" and "sender's address" of a received message and format a reply message directed to the sender's address with the same subject as the received message. The e-mail program disclosed by Stein allows an e-mail address to which the buyer's transfer-response message should be sent to be entered as the sender's address in the front-end program. Accordingly Stein cures the deficiencies of Garfinkle, because the system disclosed by Stein teaches that an e-mail address other than the system generated address may be placed as the sender's address of e-mail. Therefore, Examiner maintains that combined system of Garfinkle and Stein discloses the claimed invention.

### ***Conclusion***

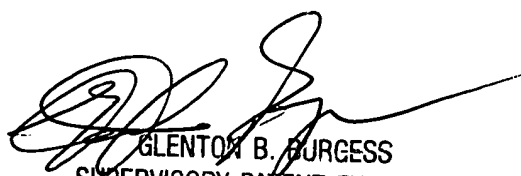
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Kimberly D Flynn  
Examiner  
Art Unit 2153

KF  
December 23, 2003

  
GLENTON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100